

REMARKS

In the October 10, 2006 Office Action, the Examiner noted that claims 1-19 were pending in the application; rejected claims 12 and 13 under the second paragraph of 35 U.S.C. § 112; rejected claims 1-10 and 14-19 under 35 U.S.C. § 102(e); and rejected claims 11-13 under 35 U.S.C. § 103(a). In rejecting the claims U.S. Patent 6,505,168 to Rothman et al. (Reference B in the October 10, 2006 Office Action). Claims 14-19 have been canceled and thus, claims 1-13 remain in the case. The rejections are traversed below.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 12 and 13 were rejected under the second paragraph of 35 USC § 112 as allegedly indefinite. Claim 12 has been amended in response to the rejection. Therefore, withdrawal of the rejection with respect to claim 12 is respectfully requested.

In rejecting claim 13, it was asserted that "the preamble of the claim is directed to a 'method of simulating relation', while the body of the claim does not recite this feature" (Office Action, page 2, lines 15-16). It is not understood why the operations recited in the body of claim 13 are not considered to constitute "simulating relation between a membership condition for a service and a number of users" (claim 13, lines 1-2). The first operation recited in claim 13 is "storing service tables ... including a membership condition of a corresponding service of the existing services" (claim 13, lines 3-5) which is followed by "designating a new membership condition" (claim 13, line 6) and then using that new membership condition, including "obtaining new member information of a number of users that can be become members of another service corresponding to the new membership condition ... and displaying the new member information" (claim 13, last four lines). It seems reasonable to summarize these operations as "simulating relation between a membership condition for a service and a number of users" as recited in the preamble of claim 13.

If this rejection is maintained, the Examiner is respectfully requested to explain why the operations recited in claim 13 do not constitute "simulating relation between a membership condition for a service and a number of users" as recited in the preamble of claim 13. If the Examiner agrees to conduct an Interview, as requested below, it is suggested that the explanation be provided at the Interview so that if any amendments are necessary, they can be made prior to issuing another Office Action.

Rejections under 35 U.S.C. § 102(e)

On pages 2-11 of the Office Action, claims 1-10 and 14-19 were rejected under 35 USC § 102(e) as anticipated by Rothman et al. Claims 14-19 have been cancelled and thus, only the rejection of claims 1-10 will be addressed below.

In making the § 102(e) rejection, it was asserted that the preference engine 22 (Fig. 4) and preference database 24 (which contains sorted customer information as described in column 10, lines 21-33 of Rothman et al.) disclosed all of the features of the storing device recited on lines 2-9 of claim 4. However, the customer information 18 input to preference engine 22 and stored after sorting in preference database 24 is described only as including "previous credit card transactions, customer profiles, customer applications, and other information" (column 10, lines 29-31). There is no suggestion in this list of data and no suggestion has been found elsewhere in Rothman et al. of anything related to "membership qualification" (claim 4, line 2). In fact, no form of the word "member" or its synonyms, "associate" and "affiliate", have been found in Rothman et al.

As a result, it is submitted that Rothman et al. is not particularly relevant to the present invention, let alone anticipatory. All of the independent claims recite a system or method (directly or as embodied by a computer-readable medium) in which the term "membership qualification" appears. In addition, claims 4, 9 and 12 recite "membership qualification tables including qualification criterion information for qualifying membership" (e.g., claim 4, lines 4-5) and claims 6 and 13 recite "comparing each membership condition of the service tables of the existing services ... with the new membership condition" (e.g., claim 6, lines 7-8). In rejecting claim 6, it was asserted that this comparison was taught by column 10, lines 21-39 of Rothman et al. However, the additional lines 32-39 of column 10 merely describe "match engine 30 [which] combines relevant customer information from the account database 28 and classified offers 16 to form a match table 32" (column 10, lines 37-39). No explanation was provided in the Office Action why the Examiner believes that matching customers with offers constitutes membership qualification as recited in all of the independent claims.

For the above reasons, it is submitted that claims 4, 6 and 9, as well as claims 1-3, 5, 7, 8, and 10 which depend therefrom, patentably distinguish over Rothman et al.

Rejections under 35 U.S.C. § 103(a)

On pages 11-13 of the Office Action, claims 11-13 were rejected under 35 USC § 103(a) as unpatentable over Rothman et al. In rejecting claim 12, column 10, lines 21-33 of Rothman et

al. was once again cited, this time as disclosing "qualification criterion information for qualifying membership" (claim 12, line 2) and all of the operations on the qualification criterion information recited in claim 12. As discussed above, no hint of "membership qualification" (claim 12, line 3) has been found in the cited portion of Rothman et al. Therefore, it is submitted that claim 12 and claim 11 which depends therefrom patentably distinguishes over Rothman et al. for the reasons discussed above.

In rejecting claim 13, the oval labeled "CLASSIFIED OFFERS" and assigned reference numeral 16 in Fig. 4 of Rothman et al. was cited as disclosing "designating a new membership condition" (claim 13, line 6). No explanation was provided regarding how offers to customers constitute a "membership condition" as recited in the claims.

Furthermore, the Office Action asserted that the words "MATCH ENGINE" in block 30 of Fig. 4 of Rothman et al. discloses "comparing each membership condition of the service tables of the existing services in a membership qualification system with the new membership condition" (claim 13, lines 7-8). It is submitted that this is absurd. The mere words "match engine" cannot possibly disclose all of the operations recited in line 7-8 of claim 13. Even when the corresponding description of the match engine at column 10, lines 37-39 is added, together with the explanation of what constitutes "relevant customer information" (column 10, lines 37-38) and "classified offers 16" (claim 10, line 38) are also added, it is submitted that there is no suggestion of the limitations recited on lines 7-8 of claim 13. No suggestion has been found of anything relating to membership conditions or membership qualification as recited on line 7-8 of claim 13.

For the above reasons, it is submitted that claim 13 patentably distinguishes over Rothman et al.

Request for Examiner Interview

In light of the citation of Rothman et al. which the inventors do not find particularly relevant to the claims and the lack of explanation of why such a reference was used to reject the claims, it is respectfully requested that the Examiner contact the undersigned prior to issuing a new Office Action, other than a Notice of Allowance. Prosecution of this application will be assisted tremendously if the Examiner will provide an explanation of the reasoning in citing a reference like Rothman et al.

Summary

It is submitted that Rothman et al. does not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-13 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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